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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,613	01/30/2004	Dwight M. Smith	27435.002	6773
75	90 09/28/2006		EXAM	INER
Constance Gall Rhebergen			ZHENG, LOIS L	
Bracewell & Pa			APTIBUT	DARED MILATER
P.O. Box 61389			ART UNIT	PAPER NUMBER
Houston, TX 77208-1389			1742	
			DATE MAILED: 09/28/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No. Applicants s							
## Examiner Lois Zheng 1742		Application No.	Applicant(s)				
Lois Zheng		10/768,613	SMITH, DWIGHT M.				
The MALLING DATE of this communication appears on the cover sheet with the correspondence address — Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extension of name may be available under the previous of 37 CFR 1.13(b). In overts, hower, may reply be timely filed 1 NO period for reply is positive above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. 1 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser begined his to be small gift and of this communication. 1 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application to be made application to be supplication to set of this communication. 2 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application from the mailing date of this communication. 3 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application (9) 4.5. € 1.13. 3 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application (9) 4.5. € 1.13. 3 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application. 4 Pallure to reply within the set or exceeded period for reply its ystatuke, ouser application of the merits is closed in accordance with the practice under Exparte Quayle, 1935 C.D. 11, 453 O.G. 213. 2 Pallure to reply application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Exparte Quayle, 1935 C.D. 11, 453 O.G. 213. 2 Pallure to reply application is objected to by the Exparten formation of Claims 4 Pallure to reply application is objected or pallure to reply application is objected to by the Exparten formation of the promote of the promote pallure to reply application for the priority documents have been received in Appli	Office Action Summary	Examiner	Art Unit				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1-33(a), in no event, however, may a reply be timely filled. - If No period for reply is specified above, the maximum statustry pand will expire 13K (9) MONTHS from the mailing date of this communication of 17 CFR 1-70(b). - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Are prely received by the Cfills clare than thin them tomal and the ren mailing date of this communication, even if timely filled, may reduce any autore part from subjustment. Sen 37 CFR 1-70(b). - Status 1) Responsive to communication(s) filled on 30 January 2005. 2a) This action is FINAL. - 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-33 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. - Claim(s) is/are allowed. - Claim(s) is/are allowed. - Claim(s) is/are rejected. - Claim(s) is/are rejected to by the Examiner. 10) The specification is objected to by the Examiner. Application Papers 9) The specification is objected to by the Examiner. Application Papers 10) The drawing(s) filed on is/are: a) cacepted or b) objected to by the Examiner. Application Papers 11) Some * C) None of: 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). 3) All b) Some * C) None of: 13) CPC Certified copies of the priority documents have been received in Application No. 14) Certified copies of the priority documents have been received in Application No. 15) Paper NocloyMail Date. 16) Interv							
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Elementor of time may be available under the provision of 30° FR1 1360, him or event, however, may a reply be timely filed after SIX (5) MCDNTHS from the mailing date of this communication. of the state of the communication of the communication. Are previously with the stat or seconded period for reply view, but yet into communication, even if timely filed, may reduce any seamed patent for the mailing date of this communication, even if timely filed, may reduce any seamed patent to mail the amounts after the mailing date of this communication, even if timely filed, may reduce any seamed patent to make many and the communication. **Paths to revolve the mail of the communication of the mail of the communication, even if timely filed, may reduce any seamed patent the adjustment. Sea 27 CFR 1.704(a). **Status** **Piled to receive the mail of the communication of the mail of the communication is non-final. **Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. **Disposition of Claims** **Application of the above claim(s) is/are pilected. **Claim(s) is/are allowed. **Claim(s) is/are rejected. **Claim(s) is/are rejected. **Claim(s) is/are rejected. **Olaim(s) is/are rejected to by the Examiner. **Application Papers** **9 The specification is objected to by the Examiner. **Application Papers** **9 The specification is objected to by the Examiner. **Application Papers** **9 The drawing(s) filed on is/are rejected to the drawing(s) be held in abeyance. Sea 37 CFR 1.85(a). **Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. Sea 37 CFR 1.121(d). **10 Acknowledgment is made of a cl		pears on the cover sheet with the c	correspondence address				
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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a phosphate coating composition, classified in class106, subclass 14.12.
- Claims 14-20, drawn to a phosphate coating process, classified in class
 subclass 253.
- III. Claims 21-25, drawn to a converted metal product, classified in class 428, subclass 432.
- IV. Claims 26-27, drawn to a lubricant composition, classified in class 508, subclass 161.
- V. Claim 28, drawn to a lubricating process, classified in class 148, subclass253.
- VI. Claims 29-32, drawn to a non-ferrous metal-phosphate conversion coating process, classified in class 148, subclass 253.
- V. Claim 33, drawn to a phosphate-metal layer product, classified in class428, subclass 472.2.
- 2. Inventions I and II are related as composition and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the composition as claimed can be practiced with another materially different composition or (2) the composition as claimed can be used in a materially different process of using that composition. In the instant case the process for using the

composition as claimed can be practiced with another materially different composition such as a zinc phosphate or ferrous phosphate containing composition.

- 3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as an electrolytic coating process.
- 4. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require the specifics of a substantial amount of an oil having a lubricating viscosity as recited in invention group IV. The subcombination has separate utility such as a lubricant.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or

includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

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- 5. Inventions IV and V are related as composition and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the composition as claimed can be practiced with another materially different composition or (2) the composition as claimed can be used in a materially different process of using that composition. In the instant case the process of invention V can be practiced with another materially different composition such as a lubricating composition that does not contain phosphorus.
- 6. Inventions II and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require the specifics of contacting a non-ferrous metal component as recited in invention group VI. The subcombination has separate utility such as a treatment solution for non-ferrous metals.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all

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the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

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- 7. Inventions II and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed process invention II can be used to make another and materially different product such as a phosphate metal layer for iron or steel alloys.
- 8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
- 9. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

ROY KING SUPERVISORY PATENT EXAMINER TECHNICALOGY CENTER 1700

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LLZ